

REMARKS

Favorable reconsideration and allowance of this application are requested.

Claims 1-17 and 31-36 remain pending in this application. As will be discussed below, since there is a bone fide dispute as to the propriety of the Examiner's restriction requirement that has been advanced against claim Groups I, II and III, no method claims have been cancelled. Moreover, as will also become evident from the discussion below, no amendments have been preferred with respect to any of the pending claims since all such claims patentably define this invention over the applied art of record.

Applicants acknowledge with appreciation the Examiner's indication of allowability of claims 2-5. As will be discussed below, however, pending claim 1 (and indeed all claims pending in this application) defines patentable subject matter over the applied reference of record.

1. Claim Status

A formal Petition to withdraw the Examiner's restriction requirement advanced against claim Groups 1, II and III, as well as previously presented claims 31-36 was filed on August 16, 2004. Since a formal decision on such Petition has not yet been issued, the noted claim status is commensurate with the claim status had no restriction requirement been made.

Thus, although the arguments below have been focused on pending claim 1, it will be observed that such arguments are equally germane to all pending claims herein. (Please see in this regard, the claim chart comparisons on pages 4 and 7 of the Petition filed August 16, 2004.) As such, pending receipt of the Director's Decision on the August 16, 2004 Petition, the Examiner is **not** authorized to cancel any of the asserted claims of Groups II and III and/or claims 31-36 should claims 1-5 otherwise been deemed to be in condition for allowance. Moreover, the filing of this response is not to

be construed as acquiescence to the Examiner's restriction requirement which is the subject of the pending Petition.

2. Response to Art-Based Rejection

The Examiner asserts that independent claim 1 is unpatentable over USP 6,595,987 to Negus as allegedly being anticipated (35 USC §102(b)) thereby. Applicants emphatically disagree.

In this regard, applicants note that the Negus '987 patent unequivocally does **not** disclose or even remotely suggest a method for detecting a phase in a cardiac cycle whereby movements of an anatomic structure affected by cardiac activity are detected **optically**. Instead, Negus '987 detects the **electrical** activity of a beating heart (via its ECG), and it is this detected **electrical** activity which is delivered to a trigger generator 18 which:

"...provides a trigger pulse 20 to laser firing circuit 22, which in turn energizes laser unit 24 including a laser power supply and a laser to produce a pulsed laser beam through articulated optical arm 26 into optical handpiece 28 **to make a hole** 30 in heart 14." (See column 6, lines 11-19, emphasis added)

Therefore, it is quite clear that Negus '987 does not disclose or suggest at all the "...optical detection of cardiac movement" as erroneously asserted in the Official Action. As such, Negus '987 cannot possibly anticipate the presently claimed invention pursuant to 35 USC §102(b).

Nor can Negus '987 even remotely be considered a reference which renders the presently claimed invention "obvious" (35 USC §103(a)). In this regard, the fact that the "optical" component of Negus '987 (i.e., the pulsed laser beam) is employed to physically form a hole in the patient's heart is self-evidently **not** suggestive at all of any

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optical detection of anatomic structure affected by cardiac activity as contemplated by the present invention.

Withdrawal of Negus '987 as a reference against the claims pending herein is therefore in order.

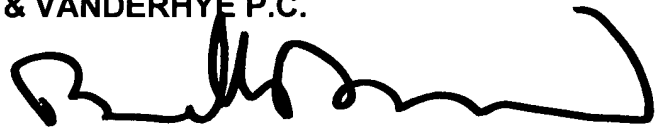
3. Conclusion

Every effort has been made to advance prosecution of this application to allowance. Therefore, in view of the remarks above, applicants suggest that all pending claims herein are in condition for prompt allowance and a formal Notice to that effect is awaited.

Respectfully submitted,

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